

Appl. No. 09/895,027  
Atty. Docket No. 8610  
Amdt. dated August 14, 2003  
Reply to Office Action of June 10, 2003  
Customer No. 27752

### REMARKS

Claims 1-20 are pending in the application and stand rejected. Claims 1-20 have been rejected under 35 U.S.C. § 103.

#### Rejection Under 35 USC 103(a) Over WO 00/64502

Claims 1-20 have been rejected under 35 USC 103(a) as being unpatentable over published PCT application No. WO 00/64502.

The Office Action has not made out a proper *prima facie* of obviousness with respect to any of Claims 1-20.

At the outset, it is noted that there are three pending independent claims in the instant application: claims 1, 9, and 16. However, the Office Action lumps all claims together and provides a single analysis directed to all of claims 1-20. In pointing out the errors in the Office Action with respect to making out a *prima facie* case of obviousness, this response will address each of the independent claims in turn.

"The claimed invention" is characterized in the office action as being directed to

"an article such as a diaper or a sponge, comprising a porous substrate having a contacting surface and an opposing surface, wherein the contacting surface is disposed with a beneficial agent and a means for minimizing migration of the beneficial agent into the porous substrate, whereby the ratio of the amount of beneficial compound present in the top third portion of the substrate is about 2.2 times the amount of the beneficial agent present in the bottom 2/3 portion of the substrate."

Applicants concede that this is an accurate general description of Claim 1. Nevertheless, a proper *prima facie* case of obviousness is not made out even with respect to this claim. The Office Action concedes that the WO '502 reference does not teach the claimed thickness of the beneficial composition on the porous substrate (i.e. 2.2 more times more in the top third than in the bottom 2/3). The Office Action goes on to find such missing teachings obvious in light of teaching viscosity enhancers in the WO '502 reference. Such a showing is insufficient. The Office Action concludes that it would have been obvious for one of skill in the art to apply the WO '502 lotion composition in the desired thickness and expect the lotion to exhibit minimum migration. The Office Action concludes that it would have been within the scope of a skilled artisan to optimize the amounts of lotion applied on the absorbent article. As to this second

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conclusion, such a showing is insufficient. The fact that one of skill in the art could have made the required modification is insufficient for an obviousness showing. The Office Action must show that one of skill in the art would have been motivated to make the required modification, not merely that it could be done with "ordinary skill."

The Office Action relies on general teaching of the desirability of minimizing migration in the WO '502 reference for motivation to modify that reference. However, such disclosure only shows that the problem at hand was known in the art. It teaches nothing about how to solve the problem, and certainly nothing about how to solve the problem in the manner claimed by applicants. Applicants note that Claim 1 is a "means plus function" claim and resort must be had to specification for the particulars of structure on how to effect the claimed function. This is not a claim merely directed to applying a prior art lotion in a particular thickness on a topsheet. The Office Action provides **no evidence** that the prior art viscosity enhancers of WO '502 would achieve the claimed result even if such a lotion were applied in a particularly thick manner. Indeed, the portions of the WO '502 reference cited in the Office Action for the conclusion, that the prior art lotion exhibited "minimum migration" still disclose that such migration was in the range of 55%. This is well above the top-biasing result claimed by applicants in Claim 1 (about 45% or less). In the end, the Office Action simply assumes the existence in the prior art of the missing claimed property, based upon nothing more than a common problem to be solved and **using applicants own disclosure against them**. Page 3 of the Office Action uses the applicants' own specification where viscosity enhancers are disclosed against them in the finding of obviousness. However, this portion of the specification is not the entire disclosure of how the invention of claim 1 is obtained. Even if it were proper to cite the applicants' specification against them, this argument would only be sufficient if the specification only disclosed a viscosity enhancer as the means to carry out Claim 1. The disclosed viscosity enhancers on page 18 of the specification are described as optional ingredients and not the sole mechanism of obtaining the claimed effect. The Office Action simply falls short of making out a *prima facie* case of obviousness of claim 1.

Claim 9 is another independent claim. The Office Action characterizes all remaining claims as "dependent" which is incorrect. There is no analysis provided in the Office Action showing how WO '502 renders the claimed layered composition obvious. Claim 9 is directed to the use of particularly chosen layers of a beneficial composition having claimed proportions. Claim 11, for example, expressly claims the particular differing properties of such layers to achieve the desired effects noted in the instant application. As the Office Action has not addressed such details at all, the applicants cannot properly respond to the rejection of these claims. It is incumbent upon the PTO in the first instance to put forth a proper *prima facie* case

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of obviousness before the applicant is required to respond with any showing. As this case has not yet been made, the rejections of Claims 9-15 should be withdrawn.

Claim 16 is also an independent claim and not a dependent claim as noted in the Office Action. There is no analysis at all in the Office Action showing how WO '502 meets the teachings of this claim either as written or as properly modified. The claimed method is directed to applying particularly chosen layers of composition in particularly chosen relative positions and ensuring that the resulting layered composition does not emulsify. The Office Action wholly ignores these claim features. Therefore, the rejections of Claims 16-20 must be withdrawn.

For all of the reasons given above, the rejections of Claims 1-20 over WO '502 are improper and should be withdrawn.

#### Comments on Finality of Office Action

The Office Action was made final supposedly due to the IDS filed in February 21, 2003 with the fee set forth in 37 CFR § 1.17(p). A closer inspection of the file wrapper reveals that this IDS was filed with the certification described in 37 CFR 1.97(e). Therefore, under MPEP Section 609, the instant Office Action should not have been made final. Nevertheless, to advance prosecution and to get examination of the claims in a timely manner, the applicants are filing this response with an RCE which should moot this issue.

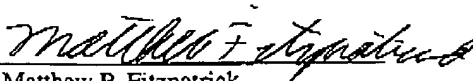
#### Conclusion

All of the relevant rejections and objections in the Office Action have been addressed.

In light of the discussions contained herein, Applicants respectfully request reconsideration of the rejections and their withdrawal and that all of the claims be allowed.

Issuance of a notice of allowance at an early date is respectfully requested.

Respectfully submitted,

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September 9, 2003  
Customer No. 27752